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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,941	09/02/2003	Yuji Arai	12049-0010	1227
22902	7590	03/10/2006	EXAMINER	
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			BOMAR, THOMAS S	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/651,941	ARAI ET AL.	
	Examiner	Art Unit	
	Shane Bomar	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3-6, 9, and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite since one of ordinary skill in the art would not readily know what the inner diameter of a non-uniform wall thickness pipe would be because the process for measuring the inside diameter has not been defined, or at least which inner diameter one uses for the equations in claim 1 has not been pointed out. For example, if I were to have the fourth order pipe from Figure 8b in front of me, what inner diameter would I use in expression 2? Would it be the inner diameter where the wall thickness is a maximum, a minimum, or somewhere in between?

Claims 3-6, 9, and 11-13 are also considered indefinite since they depend directly or indirectly from claim 1.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1, 3-6, 9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's own admission.

Regarding claim 1, pages 22-24 of the current specification state that a sampling of steel pipes were manufactured using a known production process, the wall thicknesses of the steel pipes were then measured to determine the non-uniform wall thickness ratios, the pipes were then subject to different percentages of expansion, and were then tested for collapse strength. In Table 2 it is shown that some of the pipes met the claimed E0 expression, while others did not. Therefore, it is clear that the steel pipe being claimed in claim 1 was already known to exist because it is made from a process known in the art. It is also worth noting that the claim is not directed to a steel pipe with a non-uniform wall thickness because only a ratio of the wall thickness has been presented. Therefore, if a manufacturer were to manufacture a pipe with perfect wall thickness throughout, which one would assume would be the manufacturer's ultimate goal, the perfect pipe would clearly anticipate this claim, also.

This leads me to believe that the Applicant may have actually invented a method or process to determine which steel pipes from a manufacturer meet the given E0 expression so that the collapse strength of the pipe after it is expanded is at an optimum to prevent failure of the pipe after expansion. However, as it currently stands, the steel pipe being claimed is not a novel invention and can be anticipated by many previously known, or manufactured, pipes.

Regarding claims 3-5 and 9, Table 1 shows steel pipe with the claimed compositions and, as stated above, the pipe was manufactured by a known process as per the Applicant's own admission.

Regarding claims 6 and 11-13, the Applicant has admitted in Figures 2 and 3, and on pages 2 and 3, that the claimed processes are known to exist in the prior art.

Response to Arguments

5. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lohbeck discloses a process for embedding oil well pipes with all of the claimed method limitations of claims 6 and 11-13. Asahi et al (previously cited by Examiner in an 892 form; see col. 8, lines 52-61), Anderson et al (see col. 2, lines 42-57), Kuroki et al (see col. 6, lines 21-32), and Shimizu et al (previously cited by Examiner in an 892 form; see col. 8, lines 35-45) all disclose steel pipe with a non-uniform wall thickness ratio that appears to anticipate at least claim 1.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb



March 4, 2006